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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/719,219 03/28/01 BERNARDON

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EXAMINER

ROBINSON, B

ART UNIT

PAPER NUMBER

1625

DATE MAILED:

06/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/719,219

Applicant(s)

BERNARDON ET AL.

Examiner

Binta M. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species listed on pages 7-12 as well as examples 1-70 on pages 23-67

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 1-13 and 15-20.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The species lack a common core.

During a telephone conversation with Terry Rhea on 5/31/01 a provisional election was made with traverse to prosecute the invention of example 4 on page 26. Affirmation of this election must be made by applicant in replying to this Office action.

The election of species will now be used as a reference point for the examiner to create a natural genus based on a liberal interpretation of the doctrine of legal and chemical equivalence and restriction will be required under 35 U.S.C. 121 and 372.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

A. Group I, claim(s) 1-13, 15-20, drawn to the compound in formula I in claim 1 where Ar is pyridyl, R1 is COOH, R2 and R3 come together to form a 6 membered benzo moiety substituted with methyl groups, and R4 is a lower alkyl radical.

B. Group II, claim(s) 1-13, 15-20, drawn to the compound in formula I in claim 1 where the radicals Ar, R1, R2, R3, and R4 are all other claimed moieties not defined in group I.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The species lack a common core.

Applicant's election of species falls into Group I and Group I will therefore be examined. The unelected portions of claims 1-13 and 15-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

If the subject matter in group II is pursued in a divisional application, it may be subject to further restriction.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 15 in part is rejected under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement for the method of treating all of the various diseases claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The claims as recited are broader than the scope of enablement.

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The applicant is referred to *In re Wands*, 858 f.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) which includes the incorporation of the 8 factors recited in Ex parte foreman 230 USPQ 546 (Bd. Of App. And Inter 1986).

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 1-13 in part are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. In claims 1-13 in part, the term "Compounds" is indefinite. It is unclear as to whether a compound or pharmaceutical composition is being claimed. Only one compound should be claimed in a compound claim. Appropriate clarification is required.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1-13 and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakanishi et. al. (See Reference U). Nakanishi et. al. discloses for example, the instant compound with registry number 65490-21-3. At pages 947-948 , see the instant compound.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 and 16-19 are rejected under 35 U. S. C. 103(a) as being unpatentable over Beard et. al.. (See Reference N). Beard et. al. teaches the instant compound, 3-pyridinecarboxylic acid, 2-[(5, 6, 7, 8-tetrahydro-3, 5, 5, 8, 8-pentamethyl-2-naphtalenyl)thio]. At pages 1-49, see 3-pyridinecarboxylic acid, 2-[(5, 6, 7, 8-tetrahydro-3, 5, 5, 8, 8-pentamethyl-2-naphtalenyl)thio] .

The difference between the prior art compound and the instantly claimed compound is the chalcogen atom connecting the phenyl radical to the pyridyl radical. In the instant compound, the chalcogen is selenium. In the prior art compound, the chalcogen is sulfur. Chalcogens are the elements oxygen, sulfur, selenium, tellurium, and polonium.

It would have been obvious to one of ordinary skill in the art to substitute one chalcogen for another in the synthesizing of this class of compounds. Accordingly, the compounds are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compounds over those of the generic prior art compounds.

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Claims 1-13 and 16-19 are rejected under 35 U. S. C. 103(a) as being unpatentable over Bernardon et. al. (See Reference O). Bernardon et. al. teaches the instant compound, 3-pyridinecarboxylic acid, 6-[(5, 6, 7, 8-tetrahydro-3, 5, 5, 8, 8-pentamethyl-2-naphthalenyl)thio]. At pages 1-21, see compound, 3-pyridinecarboxylic acid, 6-[(5, 6, 7, 8-tetrahydro-3, 5, 5, 8, 8-pentamethyl-2-naphthalenyl)thio].

The difference between the prior art compound and the instantly claimed compound is the chalcogen atom connecting the phenyl radical to the pyridyl radical. In the instant compound, the chalcogen is selenium. In the prior art compound, the chalcogen is sulfur. Chalcogens are the elements oxygen, sulfur, selenium, tellurium, and polonium.

It would have been obvious to one of ordinary skill in the art to substitute one chalcogen for another in the synthesizing of this class of compounds. Accordingly, the compounds are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compounds over those of the generic prior art compounds.

The reference noted as an x reference in the international search report appears to be a X reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (703) 306-5437. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703)308-7922 for regular communications and (703)308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-223.



June 18, 2001



ALAN L. ROTMAN
PRIMARY EXAMINER